REMARKS

I. Introduction

Claims 1, 2, 6-10, 12-18, 20-24, 26-37, 40-43, 45-48, and 50-63 are pending in this application. Claims 1, 2, 6-10, 12-18, 20-24, 26-34, 36, 37, 40-43, 45-48, and 50-63 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,357,042 ("Srinivasan") in view of U. S. Patent No. 5,740,549 ("Reilly"). Claim 35 stands rejected under 35 U.S.C. § 103(a) over Srinivasan. These rejections are respectfully traversed.

Each of independent claims 1, 18, 32, 36, 37, 43, 48, and 53 requires receiving at user equipment a plurality of advertisements, media, metadata relating to the media, and metadata related to the plurality of advertisements, comparing, at the user equipment, the metadata associated with the media with the metadata associated with the plurality of advertisements, and selecting one of the advertisements for display based on the comparison. The Action concedes that Srinivasan fails to describe, teach, or suggest comparing metadata at the user equipment and selecting from a plurality of advertisements received at the user equipment, but contends that Srinivasan can be combined with Reilly to make up this deficiency. Applicants disagree.

In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the conclusion of obviousness. In re Warner, 379 F.2d 1011 (CCPA 1967). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by Graham v. John Deere Co., 383 U.S. 1, (1966). "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." (MPEP 2143) While the Supreme Court, in KSR Int'l Co. v. Teleflex, Inc., 127 S.Ct. 1727 (2007) ("KSR"), determined that the teaching, suggestion, or motivation ("TSM") test cannot be applied rigidly, the Court acknowledged that the TSM test captures a helpful insight and is one of a number of valid rationales that could be used to determine obviousness (KSR, 127 S.Ct. at 1737). The Examiner fails to make a prima facie case of obviousness.

First, the Action fails to point to any section of Srinivasan or Reilly that describes, teaches, or suggests receiving, at user equipment, metadata that contains a description of the media or at least one object in the media, as specified in the independent claims. In support of

United States Patent Application No. 09/823,588
Amendment dated September 9, 2008
After Non-Final Office Action dated April 9, 2008

Docket No. UV/192

the rejection, the Examiner cites several portions of Srinivasan (including col. 5, ln. 62-col 6, ln. 19 and col. 32 lns. 22-30) and emphasizes that "advertisements, may for example, be associated with a tracked object." (Office Action, page 3.) The cited sections fail to describe, teach, or suggest metadata that contains a description of the media or at least one object in the media. Moreover, a mere reference to advertisements being associated with a tracked object does not teach or suggest that metadata included with the object contains a description of the media or at least one object in the media. In fact, Srinivasan has no need for metadata containing a description of the object or media in order to select advertisements because advertisements are selected "based on selected profile information originally provided by the user" (Srinivasan, col. 29, lns. 9-15), not based on the object or media being displayed. Reilly also fails to make for this deficiency. In particular, Reilly selects advertisements for news items based on information categories assigned to those items and user profile information, not metadata that contains a description of the media or an object in the media. Therefore, the § 103(a) rejection of the independent claims should be withdrawn for this reason alone.

Second, the Examiner here provides no rational basis outside of applicants' disclosure to suggest why one skilled in the art would be motivated to combine Srinivasan and Reilly so as to change the client-server based system in Srinivasan to a stand-alone system. In particular, Srinivasan describes a client-server based approach in which an "ad server 211 provides all retrieval and coordination of ads with broadcast video and VOD streams." (Srinivasan, col. 30, lns. 53-55, emphasis added.) Even when the primary video stream and the advertisements are delivered by different networks, "integration [is] still orchestrated by ad server 211." (Srinivasan, col. 30, lns. 63-66.) In the embodiment relied on by the Examiner, the ad server inserts URLs for ads as metadata into video streams (Srinivasan, col. 32, lines 22-31.), and the client station "use[s] the inserted metadata to pull the relevant ad or ads from the appropriate destinations on the Internet." (Srinivasan, col. 32, lines 32-34, emphasis added.) In broadcast situations, "[t]he ad server, being the controlling entity,...triggers the video server to stop the main video stream, and triggers the same or different server to begin broadcasting the appropriate ad stream." (Srinivasan, col. 32, lines 48-61, emphasis added.) Thus, Srinivasan makes it clear that the proposed personalized advertisement system requires an ad server, which acts as the controlling entity, and that ads are centralized on a server until integrated into video

United States Patent Application No. 09/823,588
Amendment dated September 9, 2008
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Docket No. UV/192

for a client. One cannot modify Srinivasan to obtain a stand-alone client without modifying its basic principles of operation.

The Examiner, nonetheless, contends that it would be obvious to modify Srinivasan based on the conflicting system of Reilly to (1) receive a plurality of advertisements at the user equipment (instead of at the ad server), (2) compare metadata associated with the advertisements and media at the user equipment (instead of integration by the ad server), and (3) select an advertisement from the local store for display based on this comparison (instead of using a URL to pull advertisements from the internet), "in order to avoid the need to pull advertisements from a remote server." (Office Action, page 5.) Applicants disagree. According to the MPEP, a "proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference." (MPEP 2145 (X)(D)) Because the proposed combination of Srinivasan with Reilly would change the principle of operation of Srinivasan, the combination is improper as a matter of law. Furthermore, "[w]here the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another." (MPEP 2143.01(II)) Here, Srinivasan requires that ads be stored on a server with an ad server serving as the controlling entity that integrates and coordinates the ads, while Reilly requires that ads be stored locally at a work station. The Examiner fails to explain why one skilled in the art faced with the conflicting choices between Srinivasan's server-based approach and Reilly's local store for ads would choose Reilly instead of Srinivasan. By so doing, the Examiner arbitrarily assumes that in any situation where Srinivasan is employed, one skilled in the art would prefer a stand-alone client to Srinivasan's server-based approach, without providing any explanation as to why such a person would be motivated to go against the central principle of operation of Srinivasan.

For at least the foregoing reasons, Srinivasan and Reilly, taken individually or in combination, fail to describe, teach, or suggest the subject matter of independent claims 1, 18, 32, 36, 37, 43, 48, and 53. Applicants therefore request reconsideration and withdrawal of the § 103 rejection of claims 1, 18, 32, 36, 43, 48, and 53. Claims 2, 6-10, 12-17, 20-24, 26-35, 40-42, 45-47, 50-52, and 54-63 depend from claims 1, 18, 32, 36, 43, and 48 and add further

elements thereto. Applicants therefore request reconsideration and withdrawal of the rejections of these claims as well for at least the same reasons.

V. Conclusion

For at least the foregoing reasons, applicants respectfully submit that this application is in condition for allowance. Reconsideration and prompt allowance of this application are respectfully requested.

We believe that we have appropriately provided for fees due in connection with this submission. However, if there are any other fees due in connection with the filing of this Response, please charge our Deposit Account No. 06-1075 under Order No. 003597-0192 from which the undersigned is authorized to draw.

Dated: September 9, 2008   Respectfully submitted,

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